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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,711	03/26/2004	Tuija Hurta	39700-613001US/NC40049US	8090

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

WILSON, ROBERT W

ART UNIT	PAPER NUMBER
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2475

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06/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,711	Applicant(s) HURTTA ET AL.	
	Examiner ROBERT W. WILSON	Art Unit 2475	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 20-23, 25, 26, 31, 34-49 and 51-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 14, 20-23, 48, & 51 is/are allowed.
- 6) ☒ Claim(s) 25-26, 31, 34-47, 49, & 52-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/4/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 25-26, 31, 33-34, & 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 25, due to the confusing language in the preamble the examiner cannot determine if applicant claim is directed to a program, processor, or method then applicant's limitations are for a steps or a method; consequently, the examiner cannot determine what statutory class the claim is directed. For purpose of examination the examiner will assume that the claim is directed to a computer program.

Referring to claim 26, the claim is directed to a communication system comprising: a gateway an access network type determination processor and a decision making processor. Next the applicant claims that "the communication system is configured to control communications based on decision by the decision making processor and the decision including the traffic control policy sent from the policy control entity to the gateway". It is unclear what structure (ie gateway, determination processor or decision making processor which is part of the communication system) is configured to control communication based on decision by the decision making processor the decision including the traffic flow control policy sent from the policy control entity to the gateway because applicant communication system.

Referring to claim 31, the claim is directed to an apparatus comprising: an access network type determining processor, transmitter, and enforcing processor. What is meant by "the apparatus further configured to receive from said policy control entity a message indicating a traffic flow control policy decided on the basis of information regarding the type of the access network"? What part of the apparatus is further configured to receive from said policy control entity a message indicating a traffic flow control policy decided on the basis of information regarding the type of the access network"?

Referring to claim 33, the claim appears to be directed to a communication system comprising: Different access networks, access network type determination processor, and a decision making processor. What is meant by different access network? Is applicant trying to refer to a first RAN and a second RAN where the first RAN is different from the second RAN? It is unclear what structure in the communication system is configured to control communication based on decision by the decision making processor the decision including the traffic flow control policy sent from the policy control entity to the gateway. What is meant by "the decisions"? There is only antecedent basis for a decision

Art Unit: 2475

Referring to claim 34, the examiner cannot ascertain whether applicant is invoking 112/6th paragraph; therefore, that makes this claim indefinite because applicant is claiming “access network type means for determining” and “means to receive”. If applicant is invoking 112/6th paragraph then applicant needs to indicate on the record that they are claiming 112/6th paragraph and amend the claim so that all of the claimed elements are in the form of means for in order to make the record clear.

Referring to claim 34, the claim limitation “access network type” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because “access network type” modifies the structure of “means for determining”. If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function. If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

Referring to claim 62, the examiner cannot ascertain whether applicant is invoking 112/6th paragraph; therefore, that makes this claim indefinite because of wording of “access network type determining means for determining”

Referring to claim 62, the claim limitation “access network type” uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because “access network type” modifies the structure of “means for determining”. If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function. If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2475

4. Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 25, claim 25 is directed to a computer program. A computer program is non-statutory subject matter.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 25, 54-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 25, applicant specification provides support for the policy control entity to send a message to the gateway indicating the policy per Para [0056]. The examiner respectfully disagrees with the applicant's argument that gateway sending a request message to the policy control entity is adequate support for "sending to the gateway from said policy control entity a message indicating said traffic flow control policy decision. Clearly sending a request for a decision is different from sending a decision. There is support for requesting a decision but applicant has not claimed requesting a decision. Applicant is claiming a message indicating flow control policy decision which is sent by the Gateway. Where is the support for the support in the specification for the gateway the message to the policy control entity indicating the traffic flow control policy decision. Applicant claim is just the opposite of what is supported by the specification; consequently, the examiner believes that the applicant has added new matter which is not supported by the specification.

Referring to claim 54, applicant specification provides support for the policy control entity to send a message to the gateway indicating the policy per Para [0056]. The examiner respectfully disagrees with the applicant's argument that gateway sending a request message to the policy control entity is adequate support for "sending to the gateway from said policy control entity a message indicating said traffic flow control policy decision. Clearly sending a request for a

Art Unit: 2475

decision is different from sending a decision. There is support for requesting a decision but applicant has not claimed requesting a decision. Applicant is claiming a message indicating flow control policy decision which is sent by the Gateway. Where is the support for the support in the specification for the gateway the message to the policy control entity indicating the traffic flow control policy decision. Applicant claim is just the opposite of what is supported by the specification; consequently, the examiner believes that the applicant has added new matter which is not supported by the specification.

Referring to claim 58 & 60, where in the applicant specification is there support for a transmitter?

Referring to claim 59, where in applicant specification is there support for a receiver?

Referring to claim 62, where in applicant's specification is there support for means for sending?

Specification Objections

7. Referring to claim 34, Claim element “means for determining, means for sending, means for enforcing” are a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

8. Referring to claim 62, Claim element “means for determining, means for deciding, & means for sending are a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

Art Unit: 2475

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

Allowable Subject Matter

9. Claims 1-12, 14, 20-23, 48, & 51 are allowed. The following is an Examiner's statement of reasons for allowance: Claims 1-12, 14, 20-23, 48, & 51 are considered allowable since no prior art reference or combination of prior art references disclose or suggest the combination of limitations specified in the independent claims including:

“receiving at the gateway from said policy control entity a message indicating a traffic flow control policy decided on the basis of information regarding the type of the access network and enforcing at the gateway in the provisioning of said service via said access network the traffic flow control policy” in combination with other claim limitations as specified in claim 1.

Response to Amendment

10. Applicant's arguments filed 3/18/10 have been fully considered but they are not persuasive.

The examiner respectfully disagrees with the applicant argument that the 101 rejection has been traversed. The amended claim 25 is now directed to a computer program product which is non-statutory.

The examiner respectfully disagrees with the applicant's argument that the 112/1st paragraph lack of written description because applicant has added new matter has been traversed. The examiner respectfully disagrees with the applicant's argument that gateway sending a request message to the policy control entity is adequate support for “sending to the gateway from said policy control entity a message indicating said traffic flow control policy decision. Clearly there is support for requesting a decision but applicant has not claimed requesting a decision. Applicant is claiming message indicating flow control policy decision which is sent by the Gateway. Applicant specification provides support for policy entity sending the decision message. The examiner asserts that the applicant is claiming just the opposite of what the specification provides support; consequently, applicant argument is not persuasive.

Applicant has not responded to the 112/1st rejection of lack of written description by defining in the specification where the support is for the means for sending or transmitter; consequently, the rejection has been maintained.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT W. WILSON whose telephone number is (571)272-3075. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dang Ton can be reached on 571/272-3171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert W Wilson/
Primary Examiner, Art Unit 2475

RWW
5/25/10